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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,578	12/26/2001	David Hooke	SW-00786	9127

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KOESTNER BERTANI LLP  
18662 MACARTHUR BLVD  
SUITE 400  
IRVINE, CA 92612

EXAMINER

ORTIZ RODRIGUEZ, CARLOS R

ART UNIT	PAPER NUMBER
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2125

8

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/025,578

Applicant(s)

HOOKE ET AL.

Examiner

Carlos Ortiz-Rodriguez

Art Unit

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12 and 14-19 is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 and 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Allowable Subject Matter***

1. Claims 9-12, 14-19 allowed.
2. Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Claim Objections***

3. Claims 3, 5-8 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph.  
  
Claim 13 recites the limitation "the computer executable logic instructions". There is insufficient antecedent basis for this limitation in the claim.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koch et al. U.S Patent No. 4,698,775 in view of Kyrazis U.S. Patent No. 5,666,202.

Regarding claim 1, Koch et al. discloses a machine for performing operations on a work-piece comprising: a carriage(see abstract lines 1-2);a movable head containing a tool for performing operations on the work-piece(see fig 1); a laser position determination system operable to determine the spatial relationship of the carriage and the work-piece and providing a first signal(laser) representative thereof (see col 2 lines 20-25) and a computer processor operable to provide a third signal to the movable head for manipulating the work-piece based on a predetermined spatial relationship between the carriage and the work-piece and to receive said first and second signals and to adjust third signal based on the actual spatial relationship between said carriage and the work-piece prior to machining(see col 2 lines 25-29).

But, Koch et al. fails to clearly specify details regarding the spatial relationship of the head to the work-piece and machining.

However, Kyrazis discloses determining the spatial relationship of said head to the work-piece during actual *machining* operations on the work-piece and providing a second signal representative thereof (see abstract lines 34-37).

Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the above invention suggested by Koch et al. and combining it with the invention disclosed by Kyrazis. The results of this combination would lead to a machine for performing machining operations on a workpiece and method of controlling the same.

One of ordinary skill in the art would have been motivated to do this modification in order to provide real time control and avoid errors in positioning as disclosed by Kyrazis.

Regarding claim 2, Koch et al. in combination with Kyrazis disclose all the limitations of base claim 1. Koch et al. further discloses the machine wherein the carriage is portable(see col 2 line 2).

Regarding claim 4, Koch et al. in combination with Kyrazis disclose all the limitations of base claim 3. Koch et al. further disclose the machine wherein the carriage includes means to lock the machine in a position in proximity to the work-piece lines(see col 7 13-14).

***Response to Arguments***

Applicant's arguments with respect to claims 1-2 and 4 have been considered but are moot in view of the new ground(s) of rejection.

***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to machine for performing machining operations on a workpiece and method of controlling same:

- a. U.S. Pat. No. 5,413,454 to Movsesian, which discloses mobile robotic arm.
- b. U.S. Pat. No. 5,647,554 to Ikegami et al., which discloses electric working apparatus supplied with electric power through power supply cord.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Ortiz-Rodriguez whose telephone number is (703) 305-8009. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P. Picard can be reached on (703) 308-0538. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Carlos Ortiz-Rodriguez

Patent Examiner

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A handwritten signature in black ink, appearing to read "L. P. Picard". The signature is fluid and cursive, with the first letter of each word being capitalized and prominent.

cror

June 1, 2004

LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100